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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,882	05/30/2001	Robert W. Naismith	12773US02	7100

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EXAMINER

NAWAZ, ASAD M

ART UNIT PAPER NUMBER

2155

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/867,882

Applicant(s)

NAISMITH, ROBERT W.

Examiner

Asad M Nawaz

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-18 are presented.

#### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig 2, 250. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

##### **Content of Specification**

3. Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of

the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."

- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et al (US Patent No. 6,338,050) further in view of Plainfield et al (US Patent No. 5,893,075).

As to claim 1, Conklin teaches a system for generating a targeted response including an internet-accessible compilation of information regarding a client corporation and a specific objectives of said client corporation; (Abstract; col 14, lines 1-14)

an e-mail database including e-mail addresses of potential interested contacts;  
(col 14, lines 24-30; col 19, lines 47-50; col 32, lines 10-15)

a login for said compilation for gathering user's contact information and providing a password to users; (col 20, lines 1-3; col 20, lines 51-53; col 26, line 2; col 32, lines 36-40)

a profile database for storing said user's contact information; col 14, lines 24-30; col 19, lines 47-50)

a use statistics database for storing web usage statistics related to said internet-accessible compilation; (Abstract; col 14, lines 24-30, 50-51, and 60-65; col 19, lines 44-45;)

Conklin, however, does not explicitly indicate the limitation of claim 1, "a targeted response generator analyzing said usage statistics to determine a targeted response from a variety of target responses based on a determination of user interest."

Plainfield teaches an interactive, customer-accessible data processing system that induces customers to enter information about themselves (i.e. name, address, dates, answers to survey questions) and thus enabling businesses to generate promotional messages tailored to customers based on the entered information. (Abstract; col 3, lines 35-38; col 6, lines 55-62)

It would have been obvious for one with ordinary skill in the art to incorporate the teachings of Plainfield into those of Conklin to make the system more efficient. By adding more data to that analyzed by Plainfield's disclosure, a better understanding of the potential customer would yield a superior positive response rate. Thus, a personal invitation to those targeted customers is more likely to be opened, read, and considered positively. (Plainfield, col 1, lines 18-41)

Claim 10 is rejected for essentially being the method of system claim 1.

As to claims 2 and 11, Conklin teaches the system of claim 1 and the method of claim 10, wherein said internet-accessible compilation is a web page. (Abstract)

As to claims 3 and 12, Conklin teaches the system of claim 1 and the method of claim 10 wherein said internet-accessible compilation is a bulletin board system. (col 1, lines 48-67) Although, Conklin rejects the use of bulletin boards, the rejection is on the basis of a perceived inability to easily produce contracts about negotiations conducted on a bulletin board based system.

As to claims 4 and 13, Plainfield teaches the system of claim 1 and the method of claim 10 wherein said user contact information includes postal mail information. (col 4, lines 8-15)

As to claims 5 and 14, Conklin teaches the system of claim 1 and the method of claim 10 wherein said user contact information includes professional contact information. (col 19, lines 47-50)

As to claims 7 and 16, Plainfield teaches the system of claim 1 and the method of claim 10 wherein said targeted response includes at least one of an individualized e-mail, a phone contact or a postal letter. (col 7, lines 19-43)

As to claims 8 and 17, Conklin teaches the system of claim 1 and the method of claim 10 wherein said e-mail database additionally alerts the potentially interested contacts by using a e-mail alert. (col 25, lines 52-67)

As to claims 9 and 18, Conklin teaches the system of claim 1 and the method of claim 10 wherein said e-mail alert includes the URL of the profile database. (col 25 and 26, lines 52-67 and 1-10 respectively)

5. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin(US Patent No. 6,338,050) and Plainfield (US Patent No. 5,893,075) as applied to claims 2 and 11 above, and further in view of Davis et al (US Patent No. 5,796,952).

As to claims 6 and 15, Davis teaches the system of claim 2 and the method of claim 11 wherein said usage statistics include at least one of session length, most requested pages, top entry pages, most downloaded files, most active organizations, and top referring sites. (Abstract; col 8, lines 6-20;)

It would have been obvious for one with ordinary skill in the art at the time the invention was made to incorporate the teachings of Davis into those of Conklin and Plainfield to make the system more efficient. By adding more specified and relevant data to that analyzed by Plainfield's disclosure, a better understanding of the potential customer would yield a superior positive response rate. Thus, a personal invitation to those targeted customers is more likely to be opened, read, and considered positively. (Plainfield, col 1, lines 18-41)

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M Nawaz whose telephone number is (703) 305-

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0094. Aftern October 18<sup>th</sup>, 2004, the examiner can be reached at (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HOSAIN ALAM  
SUPERVISORY PATENT EXAMINER